

REMARKS

Claims 1-12, 15, 16, 18, 19 and 21 are pending in the present application.

Claims 13, 14, 17 and 20 have been withdrawn from consideration by the examiner.

Claims 6 and 7 were amended to provide antecedent basis for the term "peroxygen source".

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

I. Election With Traverse

On March 19, 2004, Examiner Del Cotto telephoned Applicant's attorney. During such call the examiner separated Claims into Groups I (Claims 1-13 and 15-21) and Group II (Claim 14) from which Applicant was required to select one group for prosecution. During such call, Applicant provisionally elected Group I with traverse – Applicant affirms such election with traverse.

II. Basis For Traverse

According to MPEP § 803, a restriction requirement between patentably distinct inventions is only proper when

- 1.) The inventions are independent or distinct; and
- 2.) There is a serious burden on the Examiner if restriction is not required.

A rebuttable prima facie showing of a serious burden can be made if the Examiner shows by appropriate explanation either separate classification, status in the art, or a different field of search as defined in MPEP § 808.02.

Here, the Restriction Requirement contends that Groups I and II are distinct and have different classifications in the art. Although the examiner contends that Groups I and II are distinct and have different classifications in the art, Applicant asserts that an art search for any of Group I would be expected to yield the art that is pertinent to the patentability of each of Groups II. As a result of the foregoing, Applicant asserts that the present restriction requirement should be withdrawn.

III. Election Of Species With Traverse

During the March 19, 2004, telephone call the examiner required Applicant to elect one of the Formulas I-XX for prosecution. During such call, Applicant provisionally elected Formula I and hence Formula XI a species of Formula I with traverse – Applicant affirms such election with traverse.

IV. Basis For Traverse

According to MPEP § 806.04(a) even if a restriction requirement is proper, an Applicant is entitled to claim a reasonable number of species. Applicant asserts that a single species is less than a reasonable number. Furthermore, Applicant asserts that, at least with respect to the elected substrate, if the elected species is found patentable, the Examiner is required to expand the search to include other species. Such expanded search must be continued until an unpatentable species is found or all species are deemed allowable. See MPEP § 803.02.

ART REJECTIONS UNDER 35 USC § 112 2nd Paragraph

Claims 6 and 7 stand rejected under the second paragraph of 35 U.S.C. § 112 for failing to sufficient antecedent basis for the limitation “said peroxygen source”. Applicant contends that the amendments to Claims 6 and 7 obviate such rejection.

ART REJECTIONS UNDER 35 USC § 102(b)

According to MPEP § 2131 and § 2112, to anticipate a claim, the reference must teach every element of the claim and when an Examiner asserts that an element is inherent the Examiner must provide rationale or evidence tending to show inherency. When attempting met such a burden, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Instead, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support such assertion. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). In view of the aforementioned law, Applicant traverse the 35 U.S.C. § 102(b) rejections of their claims for the following reasons:

I. 102(b) Rejections Based On Madison et al. (USP 5,482,515)

Claims 1-10, 15, 16 and 21 stand rejected as the Examiner contends that '631 discloses an organic catalyst and bleaching composition that meets all the limitations of Applicant's claims. Applicant traverses such rejection as Claims 1-10, 15, 16 and 21 require that Applicant's catalysts have specific catalyst lifetimes. While the examiner asserts that the catalysts of '515 would inherently have such lifetimes, Applicant contends that there is no teaching or suggestion within the cited art that supports such assertion. In short, '515 generically discloses a plethora of compounds but fails to provide sufficient insight to allow one skilled in the art to select and make catalysts having the lifetimes of the catalysts that Applicant's claim and that are contained in Applicant's claimed compositions.

As a result, the 35 U.S.C. § 102(b) rejection of Applicant's claims is not supported by '515. Thus, such rejection should be withdrawn.

II. 102(b) Rejections Based On Madison. (WO 95/13353)

Claims 1-10, 15, 16 and 21 stand rejected as the Examiner contends that '353 discloses an organic catalyst and bleaching composition that meets all the limitations of Applicant's claims. Applicant traverses such rejection as Claims 1-10, 15, 16 and 21 require that Applicant's catalysts have specific catalyst lifetimes. While the examiner asserts that the catalysts of '353 would inherently have such lifetimes, Applicant contends that there is no teaching or suggestion within the cited art that supports such assertion. In short, '353 generically discloses a plethora of compounds but fails to provide sufficient insight to allow one skilled in the art to select and make catalysts having the lifetimes of the catalysts that Applicant's claim and that are contained in Applicant's claimed compositions..

As a result, the 35 U.S.C. § 102(b) rejection of Applicant's claims is not supported by '353. Thus, such rejection should be withdrawn.

ART REJECTIONS UNDER 35 USC § 102(b)/103(a)

According to MPEP Section 2143.03, to establish a case of prima facie obviousness, the cited art must teach or suggest all of an Applicant's claim limitations. In view of such requirement, Applicant traverses the 35 U.S.C. § 103(a) rejections of their claims for the following reasons:

I. 103(a) Rejections Based On Madison et al. (USP 5,482,515)

Claims 2-4, 7-9, 11, 12, 16, 18 and 19 stand rejected as the Examiner contends that '515 teaches or suggests all the limitations of Applicant's claims. Applicant traverses such rejection as the cited art fails to recognize the source of the problem that Applicant's invention solves and fails to teach, suggest or motivate one skilled in the art to do what Applicant has done.

According to MPEP § 2141.02, "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified." Consumers require low temperature bleaching performance and color safety.

While there have been improvements in the field, further improvement is desired.

Here, the cited art fails to recognize that unacceptable color damage may result from catalyst stability (See page 2, lines 10-18 of Applicant's specification). Applicant recognized a source of such problem and provided a solution. As the cited art fails to recognize such source and fails to teach or suggest Applicant's catalyst lifetime limitation, the cited art fails to support a prima facie case. As a result, the proffered 35 U.S.C. § 103(a) rejection of Applicant's claims should be withdrawn.

II. 103(a) Rejection Based On Madison. (WO 95/13353)

Claims 2-4, 7-9, 11, 12, 16, 18 and 19 stand rejected as the Examiner contends that '515 teaches or suggests all the limitations of Applicant's claims. Applicant traverses such rejection as the cited art fails to recognize the source of the problem that Applicant's invention solves and fails to teach, suggest or motivate one skilled in the art to do what Applicant has done.

According to MPEP § 2141.02, "[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified." Consumers require low temperature bleaching performance and color safety. While there have been improvements in the field, further improvement is desired. Here, the cited art fails to recognize that unacceptable color damage may result from catalyst stability (See page 2, lines 10-18 of Applicant's specification). Applicant recognized a source of such problem and provided a solution. As the cited art fails to recognize such source and fails to teach or suggest Applicant's catalyst lifetime limitation, the cited art fails to support a prima facie case. As a result, the proffered 35 U.S.C. § 103(a) rejection of Applicant's claims should be withdrawn.

DOUBLE PATENTING

Claims 1-12, 15, 16, 8, 19 and 21 stand rejected under the judicially created doctrine of obviousness double patenting as being unpatentable over:

- 1.) Claims 5-15 of co-pending application U.S. Serial No. 10/069,630;
- 2.) Claims 1-26 of co-pending application U.S. Serial No. 10/069,634;
- 3.) Claims 1-20, 25, 27-34 and 37-44 of co-pending application U.S. Serial No. 10/069,631;
- 4.) Claims 1-20, 25, 27-34 and 37-44 of co-pending application U.S. Serial No. 10/083,948; and
- 5.) Claims 1-16 and 20-25 of co-pending application U.S. Serial No. 10/069,629.

According to MPEP § 804 (II)(B)(1) an obviousness-type double patenting rejection is appropriate only when the claimed subject matter is not patentable distinct from the subject matter claimed in a commonly owned patent or patent application. Furthermore, the analysis employed in making an obviousness-type double patenting rejection parallels that used to make a 35 U.S.C. § 103 obviousness determination, except that the claims of references applied need not actually be prior art. In the present case, the basis for the double patenting rejections is that the claims of the applied references encompass the material limitations of Claims 1-12, 15, 16, 8, 19 and 21.

Prior to responding to such rejections, Applicant notes that there may be a typographical error in the examiner's listing claims that are rejected under the present double patenting rejection as in the March 24, 2004, Office Action such claim listing reads "1-12, 15, 16, 8, 19 and 21 ." Applicant assumes that Claim 8 is being rejected but request clarification as it is possible that the examiner intended to reject Claim 18.

In response to such rejections, Applicant asserts that the claims of the cited applications do not encompass all the material limitations of Applicant's claims as such claims do not contain the catalyst lifetime limitation of Applicant's claims. Furthermore, the claims of the cited applications do not teach or suggest such limitation nor would they motivate one skilled in the art to produce the claimed catalyst and compositions comprising same. As the double patenting references' do not render Applicant's amended claims obvious, such claims are patentably distinct. Thus, Applicant respectfully asserts that the double patenting rejection should be withdrawn.

CONCLUSIONS

In view of the amendments and remarks presented herein, Applicant respectfully requests that the restriction requirement be withdrawn and Claims 1-21 be allowed. In the event there are

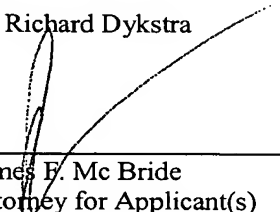
Appl. No. 10/069,632
Atty. Docket No. 7753
Amdt. Dated June 23, 2004
Reply to Office Action of March 24, 2004
Customer No. 27752

remaining issues, the Examiner is invited to call Applicant's undersigned attorney to discuss such issues.

Respectfully submitted,

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